

IV. Remarks

Claims 7 and 17-30 were previously pending.

Claims 7 and 17-30 were rejected in the present Office Action.

Claim 18 has been canceled without prejudice or disclaimer.

Claims 7, 19, 21, 24, 25 and 27-29 have been amended.

Claims 17, 20, 22, 23, 26 and 30 have been maintained in their previously-presented form.

As a result, claims 7, 17 and 19-30 are pending.

Reconsideration of claims 7, 17 and 19-30 in light of the above amendments and the following remarks is respectfully requested.

Copy of Restriction Requirement

On page 2 of the present Office Action, the Examiner requests that Applicants provide a copy of the Restriction Requirement issued by the USPTO in connection with the parent application no. 09/512,895, attorney docket no. 25791.12.02, which was filed on February 24, 2000.

In response, and in connection with U.S. utility application no. 09/512,895, enclosed is the Office Action mailed October 2, 2001, which contains a Restriction Requirement that groups the claims in U.S. utility application no. 09/512,895 into Inventions I, II, III, IV, V, VI, VII, VIII, IX, X and XI.

Information Disclosure Statements

In connection with the previously-filed Information Disclosure Statements, the present Office Action provides the following on page 2:

[i]n view of the extensive number of citations and the number of copending and/or related applications cited in the specification, applicants are asked to provide a discussion of the prior art deemed most relevant to the elected invention of Group X.

This request for a discussion of prior art deemed most relevant was also previously made in the Office Action mailed February 7, 2005. In the amendment in response to the Office Action mailed February 7, 2005, which was filed on August 4, 2005, Applicants respectfully declined to provide such a discussion.

In response to Applicants' decision to not provide such a discussion, the present Office

Action further provides the following on pages 2-3:

Applicants' statement that they decline to discuss relevant prior art of the invention X in view of their statement that it is "...generally directed to the invention of group X..." and even their not knowing what prior art statements have been filed in the instant application is not understood.

Moreover, page 3 of the present Office Action provides that "[c]onsideration of the IDS[s] which comply with 37 CFR 1.97 and 1.98 will be made when the above issues are reconsidered by the applicants."

Applicants appreciate the Examiner's detailed remarks and have reconsidered the issues raised by the Examiner.

With respect to what Information Disclosure Statements have been filed in connection with the present application, Information Disclosure Statements were filed on the following dates:

- 1) February 15, 2002 – (1) IDS filed including (1) Form 1449 having (9) pages
- 2) May 31, 2002 – (1) IDS filed including (1) Form 1449 having (6) pages
- 3) April 4, 2003 – (3) IDSs filed
 - a) Electronic IDS having EFS ID no. 25655
 - b) Electronic IDS having EFS ID no. 25658
 - c) Electronic IDS having EFS ID no. 25660
- 4) April 7, 2003 – (1) IDS filed including (1) Form 1449 having (1) page
- 5) October 31, 2003 – (2) IDSs filed
 - a) Electronic IDS having EFS ID no. 50026
 - b) IDS including (1) Form 1449 having (3) pages
- 6) August 2, 2004 – (6) IDSs filed
 - a) (1) IDS including (1) Form 1449 having (4) pages
 - b) (1) IDS including (1) Form 1449 having (1) page
 - c) (1) IDS including (1) Form 1449 having (1) page
 - d) (1) IDS including (1) Form 1449 having (1) page
 - e) Electronic IDS having EFS ID no. 65736
 - f) Electronic IDS having EFS ID no. 65713
- 7) January 25, 2005 - (5) IDSs filed
 - a) (1) IDS including (1) Form 1449 having (2) pages
 - b) (1) IDS including (1) Form 1449 having (1) page

- c) (1) IDS including (1) Form 1449 having (1) page
 - d) (1) IDS including (1) Form 1449 having (1) page
 - e) Electronic IDS having EFS ID no. 76653
- 8) August 30, 2005 – (5) IDSs filed
- a) (1) IDS including (1) Form 1449 having (1) page
 - b) (1) IDS including (1) Form 1449 having (1) page
 - c) (1) IDS including (1) Form 1449 having (4) pages
 - d) Electronic IDS having EFS ID no. 91612
 - e) Electronic IDS having EFS ID no. 91613
- 9) January 31, 2006 – (1) IDS filed including (12) single-page Form 1449s.

As a result, (25) information disclosure statements have been filed in the present application.

With respect to a discussion of the prior art deemed most relevant to the elected invention of Group X—with “Group X” referring to the Invention X referenced in the attached Office Action mailed October 2, 2001 for U.S. utility application no. 09/512,895—Applicants have reconsidered the Examiner’s request that Applicants provide such a discussion and respectfully submit the following comments.

(1) *The MPEP requires the Examiner to consider all of the cited references.*

MPEP §609.05(b) provides that “[e]xaminers must consider all citations submitted in conformance with the rules.” Therefore, the Examiner is required to consider all of the cited references that are in conformance with Title 37, Code of Federal Regulations.

(2) *The request that Applicants discuss prior art deemed most relevant is not supported by any rule.*

Applicants find no rule either in Title 37, Code of Federal Regulations, or in the MPEP, that requires Applicants to discuss prior art deemed most relevant, after Applicants have already identified and cited references in compliance with 37 CFR §1.56. Although the MPEP does suggest avoiding submitting long lists of documents if it can be avoided (*see* MPEP §2004 ¶13), Applicants respectfully note that this is only a “suggestion,” rather than a requirement (*see*

MPEP §2004, text immediately preceding ¶1), and, more importantly, Applicants respectfully submit that the amount of the cited references is a reflection of Applicants' efforts to fulfill the Duty of Disclosure. Further, Applicants respectfully note that the Examiner has not cited any rule in support of the request to discuss prior art deemed most relevant. Therefore, the Examiner is required to consider all of the cited references.

- (3) ***Moreover, the request that Applicants discuss prior art deemed most relevant requires Applicants to make, and rely on, their own determinations of materiality, a course of action discouraged by the MPEP.***

During its discussion of the Duty of Disclosure, MPEP §2001.04 expressly presumes that:

applicants will continue to submit information for consideration by the Office in applications rather than making and relying on their own determinations of materiality. An incentive remains to submit the information to the Office because it will result in a strengthened patent and will avoid later questions of materiality and intent to deceive (emphasis added).

Moreover, MPEP §2001.05 indicates that:

[t]he Office believes that most applicants will wish to submit [] information, however, even though they may not be required to do so, to strengthen the patent and avoid the risk of an incorrect judgment on their part on materiality or that it may be held that there was an intent to deceive the Office (emphasis added).

Here, if Applicants were to follow the Examiner's request and discuss prior art *already identified and cited* but now deemed most relevant, Applicants would be making a materiality determination. Thus, in full accordance with the MPEP, Applicants do not intend to make and rely on their own determinations of materiality, and further wish to avoid the risk of an incorrect judgment on their part on materiality. Therefore, the Examiner is required to consider all of the cited references.

In view of all of the above, Applicants respectfully petition the Examiner to consider all of the references cited in the previously-filed Information Disclosure Statements, and to take the necessary action to provide a clear record that all of the cited references have indeed been considered. See MPEP §609.05(b).

Rejections Under 35 U.S.C. §103(a)

Claim 7

Claim 7 stands rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. No. 5,181,010 to Stout et al. ("Stout"). Insofar as it may be applied against the present claims, this rejection is respectfully traversed.

As the PTO recognizes in MPEP §2142:

The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness.

The Examiner clearly cannot establish a *prima facie* case of obviousness in connection with claim 7, as amended, for the following reasons.

Amended claim 7 recites: A method of controlling the flow of fluidic materials within a tubular housing that defines an inlet passage and one or more outlet passages, comprising:
injecting fluidic materials into the inlet passage;
blocking the inlet passage;
conveying the injected fluidic materials radially out of the inlet passage into a plurality of spaced apart longitudinal passages defined in the tubular housing and into an annular chamber defined in the tubular housing that surrounds the inlet passage;
and
opening the outlet passages to permit fluidic materials within the inlet passage and the annular chamber to be conveyed out of the housing.

35 U.S.C. §103(a) provides that:

[a] patent may not be obtained ... if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains ... (emphasis added)

Thus, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. However, Stout does not teach, suggest or motivate a method of controlling the flow of fluidic materials within a tubular housing that defines an inlet passage and one or more outlet passages, comprising injecting fluidic materials into the inlet passage; blocking the inlet passage; conveying the injected fluidic materials radially out of the inlet passage into a plurality of spaced apart longitudinal passages defined in the tubular housing and into an annular chamber defined in the tubular housing that surrounds the inlet passage; and opening

the outlet passages to permit fluidic materials within the inlet passage and the annular chamber to be conveyed out of the housing, as claimed in claim 7.

In contrast to claim 7, Stout only teaches a port 134 that, under some conditions, permits fluid communication between the tubing chamber 26 and an annular chamber at least partially defined by the outside surface of the mandrel 68 (see Stout, Figs. 4A and 4B). Stout does not teach, suggest or motivate conveying injected fluidic materials radially out of an inlet passage into a plurality of spaced apart longitudinal passages defined in a tubular housing and into an annular chamber defined in the tubular housing that surrounds the inlet passage; and opening outlet passages to permit fluidic materials within the inlet passage and the annular chamber to be conveyed out of the housing.

Therefore, it is impossible to render the subject matter of claim 7 as a whole obvious based on Stout, and the above explicit terms of the statute cannot be met. As a result, the Examiner's burden of factually supporting a prima facie case of obviousness clearly cannot be met with respect to claim 7, and a rejection under 35 U.S.C. §103(a) is not applicable.

There is still another compelling, and mutually exclusive, reason why Stout cannot be applied to reject claim 7 under 35 U.S.C. §103(a).

The PTO also provides in MPEP §2142:

[T]he examiner must step backward in time and into the shoes worn by the hypothetical "person of ordinary skill in the art" when the invention was unknown and just before it was made. In view of all factual information, the examiner must then make a determination whether the claimed invention "as a whole" would have been obvious at that time to that person. ...[I]mpermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.

Here, Stout does not teach, suggest or motivate the desirability of the subject matter of claim 7 since the patent does not teach, suggest or motivate providing a method of controlling the flow of fluidic materials within a tubular housing that defines an inlet passage and one or more outlet passages, comprising injecting fluidic materials into the inlet passage; blocking the inlet passage; conveying the injected fluidic materials radially out of the inlet passage into a plurality of spaced apart longitudinal passages defined in the tubular housing and into an annular chamber defined in the tubular housing that surrounds the inlet passage; and opening the outlet passages to permit fluidic materials within the inlet passage and the annular chamber to be conveyed out of the housing, as claimed in claim 7.

Thus, Stout does not provide any incentive or motivation supporting the desirability of the subject matter of claim 7. Therefore, there is simply no basis in the art to support a rejection

of claim 7 under 35 U.S.C. §103(a).

For all of the foregoing reasons, it is requested that the rejection of claim 7 under 35 U.S.C. §103(a) over Stout be withdrawn.

Claim 17

Claim 17 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Stout. Claim 17 depends from, and further limits, claim 7 in a patentable sense and therefore is allowable for at least the same reasons as noted above with respect to claim 7.

Claim 18

Claim 18 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Stout. Claim 18 has been canceled without prejudice or disclaimer and therefore this rejection is no longer applicable.

Claim 19

Claim 19 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Stout. Claim 19 depends from, and further limits, claim 7 in a patentable sense and therefore is allowable for at least the same reasons as noted above with respect to claim 7. Moreover, Stout does not teach, suggest or motivate preventing debris from entering the annular chamber, as recited in claim 19, and therefore claim 19 further distinguishes over the prior art. For the foregoing reasons, it is respectfully submitted that claim 19 is in condition for allowance.

Claims 20 and 21

Claims 20 and 21 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Stout. Claims 20 and 21 depend from, and further limit, claim 7 in a patentable sense and therefore are allowable for at least the same reasons as noted above with respect to claim 7.

Claim 22

Claim 22 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Stout. Claim 22 depends from, and further limits, claim 7 in a patentable sense and therefore is allowable for at least the same reasons as noted above with respect to claim 7. Moreover, Stout does not teach, suggest or motivate controlling the rate at which the fluidic materials are conveyed out of the tubular housing through the outlet passages using variable orifices

positioned within and fluidically coupled to the outlet passages, as recited in claim 22, and therefore claim 22 further distinguishes over the prior art. For the foregoing reasons, it is respectfully submitted that claim 22 is in condition for allowance.

Claim 23

Claim 23 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Stout. Claim 23 depends from, and further limits, claim 7 in a patentable sense and therefore is allowable for at least the same reasons as noted above with respect to claim 7.

Claim 24

Claim 24 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Stout. Claim 24 depends from, and further limits, claim 7 in a patentable sense and therefore is allowable for at least the same reasons as noted above with respect to claim 7. Moreover, Stout does not teach, suggest or motivate conveying the injected fluidic materials into a plurality of circumferentially spaced apart longitudinal valve chambers fluidically coupled to corresponding outlet passages that each include corresponding movable valve members, as recited in claim 24, and therefore claim 24 further distinguishes over the prior art. For the foregoing reasons, it is respectfully submitted that claim 24 is in condition for allowance.

Claim 25

Claim 25 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Stout. Claim 25 depends from, and further limits, claim 24 in a patentable sense, and claim 24 depends from, and further limits, claim 7 in a patentable sense. Therefore, claim 25 is allowable for at least the same reasons as noted above with respect to claims 7 and 24.

Claim 26

Claim 26 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Stout. Claim 26 depends from, and further limits, claim 24 in a patentable sense, and claim 24 depends from, and further limits, claim 7 in a patentable sense. Therefore, claim 26 is allowable for at least the same reasons as noted above with respect to claims 7 and 24. Moreover, Stout does not teach, suggest or motivate a method wherein the valve chambers are interleaved among the longitudinal passages, as recited in claim 26, and therefore claim 26 further

distinguishes over the prior art. For the foregoing reasons, it is respectfully submitted that claim 26 is in condition for allowance.

Claim 27

Claim 27 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Stout. Claim 27 depends from, and further limits, claim 7 in a patentable sense and therefore is allowable for at least the same reasons as noted above with respect to claim 7. Moreover, Stout does not teach, suggest or motivate a method wherein blocking the inlet passage comprises blocking the inlet passage by placing a ball plug into a throat passage defined in the inlet passage; and further comprising preventing debris from entering the annular chamber, as recited in claim 27, and therefore claim 27 further distinguishes over the prior art. For the foregoing reasons, it is respectfully submitted that claim 27 is in condition for allowance.

Claim 28

Claim 28 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Stout. Claim 28 depends from, and further limits, claim 7 in a patentable sense and therefore is allowable for at least the same reasons as noted above with respect to claim 7. Moreover, Stout does not teach, suggest or motivate a method wherein opening the outlet passages comprises detecting the operating pressure of the injected fluidic materials; if the detected operating pressure of the injected fluidic materials exceeds about 500 to 3,000 psi, then displacing valve members positioned within corresponding longitudinal valve chambers defined in the tubular housing; and controlling the rate at which the fluidic materials are conveyed out of the tubular housing through the outlet passages using variable orifices positioned within and fluidically coupled to the outlet passages, as recited in claim 28, and therefore claim 28 further distinguishes over the prior art. For the foregoing reasons, it is respectfully submitted that claim 28 is in condition for allowance.

Claim 29

Claim 29 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Stout. Claim 29 depends from, and further limits, claim 7 in a patentable sense and therefore is allowable for at least the same reasons as noted above with respect to claim 7. Moreover, Stout does not teach, suggest or motivate a method wherein the outlet passages are orthogonal to the inlet passage; and further comprising conveying the injected fluidic materials into a

plurality of circumferentially spaced apart longitudinal valve chambers fluidicly coupled to corresponding outlet passages that each include corresponding movable valve members, as recited in claim 29, and therefore claim 29 further distinguishes over the prior art. For the foregoing reasons, it is respectfully submitted that claim 29 is in condition for allowance.

Claim 30

Claim 30 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Stout. This rejection is respectfully traversed.

Claim 30 recites: A method for controlling the flow of fluidic materials within a tubular housing defining an inlet passage for conveying the fluidic materials into the housing and one or more outlet passages for conveying fluidic materials out of the housing, comprising:

- injecting fluidic materials into the inlet passage;
- blocking the inlet passage by placing a ball plug into a throat passage defined in the inlet passage;
- conveying the injected fluidic materials radially out of the inlet passage into a plurality of spaced apart longitudinal passages defined in the tubular housing and into an annular chamber defined in the tubular housing and surrounding the inlet passage;
- preventing debris from entering the annular chamber;
- detecting the operating pressure of the injected fluidic materials;
- if the detected operating pressure of the injected fluidic materials exceeds about 500 to 3,000 psi, then displacing valve members positioned within corresponding longitudinal valve chambers defined in the tubular housing to thereby permit fluidic materials within the inlet passage to be conveyed radially out of the tubular housing through a plurality of outlet passages; and
- controlling the rate at which the fluidic materials are conveyed out of the tubular housing through the outlet passages using variable orifices positioned within and fluidicly coupled to the outlet passages.

As discussed above, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. However, Stout does not teach, suggest or motivate a method for controlling the flow of fluidic materials within a tubular housing defining an inlet passage for conveying the fluidic materials into the housing and one or more outlet passages for conveying fluidic materials out of the housing, comprising injecting fluidic materials into the inlet passage; blocking the inlet passage by placing a ball plug into a throat passage defined in the inlet

passage; conveying the injected fluidic materials radially out of the inlet passage into a plurality of spaced apart longitudinal passages defined in the tubular housing and into an annular chamber defined in the tubular housing and surrounding the inlet passage; preventing debris from entering the annular chamber; detecting the operating pressure of the injected fluidic materials; if the detected operating pressure of the injected fluidic materials exceeds about 500 to 3,000 psi, then displacing valve members positioned within corresponding longitudinal valve chambers defined in the tubular housing to thereby permit fluidic materials within the inlet passage to be conveyed radially out of the tubular housing through a plurality of outlet passages; and controlling the rate at which the fluidic materials are conveyed out of the tubular housing through the outlet passages using variable orifices positioned within and fluidically coupled to the outlet passages, as claimed in claim 30.

In contrast to claim 30, Stout does not teach, suggest or motivate both conveying the injected fluidic materials radially out of the inlet passage into the longitudinal passages and into an annular chamber defined in the tubular housing and surrounding the inlet passage, and displacing valve members positioned within corresponding longitudinal valve chambers defined in the tubular housing to thereby permit fluidic materials within the inlet passage to be conveyed radially out of the tubular housing through a plurality of outlet passages. Instead, Stout only teaches a port 134 that, under some conditions, permits fluid communication between the tubing chamber 26 and an annular chamber at least partially defined by the outside surface of the mandrel 68 (see Stout, Figs. 4A and 4B).

In further contrast to claim 30, Stout does not teach, suggest or motivate preventing debris from entering the annular chamber.

In further contrast to claim 30, Stout does not teach, suggest or motivate controlling the rate at which the fluidic materials are conveyed out of the tubular housing through the outlet passages using variable orifices positioned within and fluidically coupled to the outlet passages.

Therefore, it is impossible to render the subject matter of claim 30 as a whole obvious based on Stout, and the above explicit terms of the statute cannot be met. As a result, the Examiner's burden of factually supporting a prima facie case of obviousness clearly cannot be met with respect to claim 30, and a rejection under 35 U.S.C. §103(a) is not applicable.

There is still another compelling, and mutually exclusive, reason why Stout cannot be applied to reject claim 30 under 35 U.S.C. §103(a). Here, Stout does not teach, suggest or motivate the desirability of providing the subject matter of claim 30, as described above.

Thus, Stout does not provide any incentive or motivation supporting the desirability of

the subject matter of claim 30. Therefore, there is simply no basis in the art to support a rejection of claim 30 under 35 U.S.C. §103(a).

For all of the foregoing reasons, it is requested that the rejection of claim 30 under 35 U.S.C. §103(a) over Stout be withdrawn.

Conclusion

It is believed that all matters set forth in the Office Action mailed December 14, 2005 have been addressed. Applicants have made a diligent effort to advance the prosecution of this application by canceling claim 18, amending claims 7, 19, 21, 24, 25 and 27-29, and submitting arguments in support of the patentability of claims 7, 17 and 19-30.

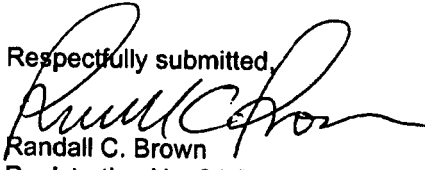
In view of all of the above, the allowance of claims 7, 17 and 19-30 is respectfully requested.

Unless stated otherwise, the amendments to the claims were not made for reasons substantially related to the statutory requirements for patentability.

Furthermore, unless stated otherwise, the amendments to the claims were made to simply make express what had been implicit in the claims as originally worded and therefore none of the amendments to the claims is a narrowing amendment that would create any type of prosecution history estoppel. In addition, to the extent that any formerly dependent claim is now presented in independent form, such an amendment does not constitute a narrowing amendment that surrenders any subject matter.

The Examiner is invited to call the undersigned at the below-listed telephone number if a telephone conference would expedite or aid the prosecution and examination of this application.

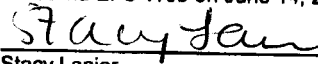
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Stacy Lanier

Attachment:

Office Action mailed October 2, 2001 for U.S. utility patent application no. 09/512,895

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